



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/501,393

01/13/2005

Andrew Lennard Lewis

Q82517

2458

23373 7590 04/01/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

NOTIFICATION DATE

DELIVERY MODE

04/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No. 10/501,393	Applicant(s) LEWIS, ANDREW LENNARD	
	Examiner BLESSING M. FUBARA	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-78 is/are pending in the application.
- 4a) Of the above claim(s) 38-40, 56-63, 65, 66 and 71-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-37, 41-55, 64 and 67-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>7/6/09</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Art Unit: 1618

DETAILED ACTION

1. The examiner acknowledges receipt of supplemental amendment and remarks filed 1/20/2010. Claims 33, 34 and 68 have been amended on 10/13/09 and 1/20/2010. Claims 33-78 are pending. Claims 38-40, 56-63, 65, 66 and 71-78 are withdrawn from consideration. Claims 33-37, 41-55, 64 and 67-70 are under examination.

Response to Arguments

2. Previous rejections that are not reiterated herein are withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 33-37, 41-55, 64 and 67-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description.

6. Claim 33 is directed to a process in which zwitterionic monomer I is polymerized in a living radical polymerization process in the presence of catalyst and initiator. There is no

Art Unit: 1618

description for the product made by the process and the claims have not identified the polymer product formed. The claim has been amended to say that the process forms a compound that is conjugate of a polymer and a biologically active moiety. However, the claim does not say what the product is that is formed and one cannot make what one does not know.

7. It is suggested that applicant name the product made without introducing new matter into the claims and/or specification.

Response to Arguments

8. Applicant's arguments filed 10/13/09 have been fully considered but they are not persuasive.

9. Applicant indicates that the amendment to claim 33 provides written description for the product formed and the examiner disagrees because "forming a compound which is a conjugate of a polymer and a biologically active moiety" is not a description for what product is formed. There is no description of how the biologically active compound is attached.

10. Claims 33-37, 41-55, 64 and 67-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 33 appears to be forming a compound that has a biological moiety conjugated to a polymer. However, the initiator defined as formula V has R¹³ that is selected from biologically active group substituted alkyl It is unclear how the substituted biological moiety initiates the polymerization and conjugates to the polymer.

12. Claim 33 defines the initiator as formula V. When R¹³ in claim 33 is -CO R¹⁵ and R¹⁵ is R¹¹ or R¹² and which is = H, the initiator VI where R⁴¹ and R⁴² are H, then formula VI does not further limit the initiator V.

Art Unit: 1618

13. Claim 34, 37 have not defined what R⁴³ is. It is thus unclear how claim 34 can define all the variations of initiators defined by claim 33. Thus claim 34 improperly depends on claim 33.

14. It would appear that claim 33 can select the initiator from formula V and VI so that claim 34 would then properly limit the initiator to formula VI.

Response to Arguments

15. Applicant's arguments filed 1/20/2010 and have been fully considered but they are not persuasive.

16. Applicant indicates that amendment to the claims overcomes the objection to claim 34.

But as stated in the objection above, the initiator VI of claim 34 does not appear to further limit the initiator V of claim 33 in at least one of the parameters identified in the rejection above.

17. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “aromatic nitrogen-, phosphorous-, or sulfur ” in claim 68 is used by the claim to mean “Het”, while the accepted meaning is “nitrogen or phosphorous or sulfur containing aromatic ring. The term is indefinite because the specification does not clearly redefine the term. Thus, stating that nitrogen is aromatic is contrary to the meaning of nitrogen.

18. No claim is allowed.

Art Unit: 1618

19. Applicant's attorney and the examiner has had extensive discussion on how to correct the deficiencies observed but, the amendments have not taken care of all such as what is described above.

20. In order to advance prosecution, applicant may consider calling the examiner to discuss the remaining issues.

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on Monday to Thursday from 7 a.m. to 5:30 p.m.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1618

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/
Primary Examiner, Art Unit 1618